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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214020
Party	Defendant Google Inc.
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Date	03/12/2014
Attachments	FINAL 3_12 Motion to Suspend or Consolidate.pdf(1682506 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 85/723,835

For the mark: GOOGLE GLASS

Published in the *Official Gazette*: June 18, 2013

FACTORY HOLDING COMPANY 25, S.L.)	
)	
Opposer,)	
)	Opposition No. 91214017
v.)	
)	
GOOGLE INC.,)	
)	
Applicant.)	
<hr/>		
BORDER STYLO, LLC)	
)	
Opposer,)	
)	Opposition No. 91214020
v.)	
)	
GOOGLE INC.,)	
)	
Applicant.)	
<hr/>		

**GOOGLE’S MOTION TO SUSPEND THE OPPOSITIONS AND CONSOLIDATE
THE CANCELLATION ACTIONS OR, IN THE ALTERNATIVE,
CONSOLIDATE ALL PROCEEDINGS**

Pursuant to 37 C.F.R §2.117(a) and TBMP 510.02(a), Google Inc. (“Google”) moves to suspend Opposition Nos. 91214017 and 91214020 (the “Oppositions”) filed respectively by Factory Holding Company 25, S.L. (“Factory Holding”) and Border Stylo, LLC (“Border Stylo”) (collectively, “Opposers”) against Google’s application to register the mark GOOGLE GLASS (Serial No. 85/723,835), and to consolidate the cancellation actions which Google recently filed against U.S. Registration No. 3,797,151 for the mark GLASS (the “GLASS mark”), which both Factory Holding and Border Stylo claim to own, and U.S. Registration No. 3,883,602 for the

mark WRITE ON GLASS, allegedly owned by Border Stylo (the "Cancellation Actions"). In the alternative, pursuant to Federal Rule of Civil Procedure 42(a) and TBMP 511, Google moves to consolidate both Oppositions with the Cancellation Actions.

I. INTRODUCTION

Both Factory Holding and Border Stylo claim ownership of the GLASS mark and registration, and rely on that same mark and registration to oppose, in separate oppositions, Google's application to register its GOOGLE GLASS mark. Ownership of the GLASS mark and registration is therefore a fundamental question in both Oppositions.

Google respectfully submits that before considering the Oppositions, the Board should determine this question of ownership by consolidating and resolving Google's Cancellation Actions. Google should not be forced to defend against two oppositions filed by rival owners of the same GLASS mark and registration, which Google argues has been abandoned based on the actions of Factory Holding and Border Stylo. The Board's rulings on the questions of ownership and validity presented in the Cancellations Actions are distinct from the question of infringement presented in the Oppositions. Likewise, the scope of discovery for the Cancellation Actions is significantly more narrow than that called for by the Oppositions. Neither the Board nor Google should be burdened by the pending Oppositions until after the Board resolves the ownership and validity issues raised in the Cancellation Actions because the outcome of the actions will render at least one, if not both, of the Oppositions moot.

In the alternative, Google requests that the Board consolidate the Oppositions and the Cancellation Actions into a single proceeding in the interest of judicial economy and to reduce the costs to be incurred by the parties.

II. PROCEDURAL & FACTUAL BACKGROUND

On March 23, 2009, Border Stylo filed trademark applications for the GLASS mark (Serial No. 77/697,375) and the WRITE ON GLASS mark (Serial No. 77/697,379) covering “computer software for enabling users to create customizable text and visual effects on existing websites, and to enable the viewing and sharing of digital images, information and data available on global computer networks; computer software to enable browsing of websites” in Class 9. The GLASS application matured to a registration on June 1, 2010 (U.S. Registration No. 3,797,151), while the WRITE ON GLASS application matured to a registration on November 30, 2010 (U.S. Registration No. 3,883,602).

On December 18, 2012, Mr. Francisco Ortiz von Bismarck, purportedly acting on behalf of Border Stylo, executed an agreement assigning all rights, title, and interest in and to the GLASS mark and registration to Factory Holding (the “Initial Assignment”). *See generally* Ex. A (Initial Assignment). On August 21, 2013, however, Mr. von Bismarck executed a purported corrective assignment (the “Purported Corrective Assignment”) declaring that he had no authority to execute the Initial Assignment on behalf of Border Stylo and that the Initial Assignment was therefore invalid and ineffective to transfer ownership of the GLASS mark and registration. *See* Ex. B (Purported Corrective Assignment) at ¶¶ 7-8, 10.

Apparently, Border Stylo and Factory Holding continue to dispute the ownership of the GLASS mark and registration because each filed an opposition against the GOOGLE GLASS application on December 16, 2013 relying, in significant part, on purported rights in the GLASS mark and registration. *See* Notice of Opposition by Factory Holding, Dec. 16, 2013 (“FH Opp’n”), at ¶¶ 4, 8; Notice of Opposition by Border Stylo, Dec. 16, 2013 (“BS Opp’n”) at ¶ 1. Specifically, both Opposers allege that Google’s use of the GOOGLE GLASS mark is likely to

cause confusion in the marketplace with the GLASS mark.¹ FH Opp'n at ¶¶ 11-13; BS Opp'n at ¶¶ 4-8. Border Stylo also relies on its purported rights in the WRITE ON GLASS mark and registration, which Border Stylo alleges is a member of its family of GLASS-formative marks. BS Opp'n at ¶¶ 1-3.

Google filed a petition to cancel the GLASS registration on March 4, 2014 (Cancellation No. 92058784), and filed a petition to cancel the WRITE ON GLASS registration on March 6, 2014 (Cancellation No. 92058815). Ex. C (Pet. to Cancel GLASS Registration); Ex. D (Pet. to Cancel WRITE ON GLASS Registration). In the Cancellation Actions, Google alleged, among other things, that the registrations are invalid and the Initial Assignment had no effect because Border Stylo abandoned all rights in the GLASS mark, the WRITE ON GLASS mark, and any other GLASS-formative marks. Ex. C at ¶¶ 15-16; Ex. D at ¶ 11. Alternatively, Google alleges that the Initial Assignment was ineffective to transfer the goodwill associated with the GLASS mark and thus the assignment constituted an assignment in gross which resulted in an abandonment of the entire family of GLASS-formative marks allegedly owned by Border Stylo and Factory Holding. Ex. C at ¶ 17; Ex. D at ¶ 12. Thus, the outcomes of the Cancellation Actions have a direct bearing on the pending Oppositions and may, in fact, be dispositive of them.

III. ARGUMENT

A. The Board Should Suspend the Oppositions Until the Disposition of the Cancellation Actions.

When "parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be

¹ In addition, in its Notice of Opposition, Factory Holding asserts rights in a number of other GLASS-formative marks and related trademark applications; however, Factory Holding filed each application after Google's March 14, 2012 latest priority date for its GOOGLE GLASS application.

suspended until termination of the civil action or the other Board proceeding." 37 C.F.R. §2.117(a); TBMP 510.02(a). The Board has routinely granted motions to suspend where the outcome of a pending proceeding is found to "have a direct bearing on the question of the rights of the parties . . . and may in fact completely resolve all the issues." *Whopper-Burger v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); *see also Gen. Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ2d 1933, 1036-37 (TTAB 1992) (granting motion to suspend where "[a] decision [whether to cancel trademark registrations] will be dispositive of the issues before the Board").

There is no doubt that the outcome of the Cancellation Actions will have a direct bearing on the Oppositions because the Cancellation Actions present the question of whether either Factory Holding or Border Stylo own any rights in any GLASS mark sufficient to give them standing to oppose GOOGLE GLASS. Google alleges in its Petitions to Cancel that Border Stylo abandoned any rights in the GLASS mark, the WRITE ON GLASS mark, and any other GLASS-formative marks either directly through non-use without an intent to resume use or indirectly through its assignment of the GLASS mark and registration to Factory Holding. Ex. C at ¶¶ 15-17; Ex. D at ¶¶ 11-12. If the Board holds that Border Stylo abandoned any such rights, it must conclude that the GLASS and WRITE ON GLASS registrations are invalid and that Border Stylo had no rights to assign to Factory Holding. Similarly, if the Board finds that Border Stylo had rights in the marks but holds that the Initial Assignment was an assignment in gross, the Board must conclude that the assignment did not transfer any rights in the GLASS mark to Factory Holding. Alternatively, even if the Initial Assignment is deemed effective, the Board may well hold that the Initial Assignment destroyed any rights in Border Stylo's alleged GLASS-formative marks, as well as Factory Holding's purported rights in the GLASS mark, by

separating the goodwill associated with the GLASS mark from the rest of the family. Finally, the Board may also find that Factory Holding subsequently abandoned its alleged rights in the GLASS mark by failing to use the mark in connection with the goods and services at issue. Thus, at the very least, the outcome of the Cancellation Actions will clarify whether either Opposer actually owns rights in the GLASS mark and registration and, more significantly, may in fact be entirely dispositive of both Oppositions.

Accordingly, Google respectfully requests that the Board consolidate the Cancellation Actions and suspend the Oppositions pending the outcome of the Cancellation Actions. By doing so, the Board may avoid rendering mooted or conflicting opinions in the Oppositions while the Cancellation Actions are pending.

B. In the Alternative, the Board Should Consolidate the Oppositions and the Cancellation Actions into a Single Proceeding.

Google moves in the alternative for the Oppositions to be consolidated with the Cancellation Actions into a single proceeding. “When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases.” TBMP § 511; *see also* Fed. R. Civ. P. 42(a); *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1046 (TTAB 2008) (consolidating proceedings “involving identical parties, an identical registration and related issues”); *Hilson Research Inc. v. Soc’y for Human Res. Mgmt.*, 27 USPQ2d 1423, at n.1 (TTAB 1993) (allowing consolidation of opposition and cancellation proceedings).

1. The Oppositions and Cancellation Actions Involve Identical Parties, Highly Similar Marks, and Common Issues of Fact and Law.

Consolidation is appropriate here because the Oppositions and Cancellation Actions involve the same parties, the same and highly similar marks, and common issues of law and fact. *See World Hockey Ass’n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975)

(oppositions involving similar marks and similar issues consolidated); *Federated Dept. Stores, Inc. v. Gold Circle Ins. Co.*, 226 USPQ 262, 263 (TTAB 1985) (consolidation permitted due to substantially similar issues of fact and law). Both Opposers allege rights in the GLASS mark and registration; both Opposers allege that their rights in purported families of GLASS-formative marks will be infringed by the registration of the GOOGLE GLASS mark; and Google has challenged both Opposers' alleged trademark rights. *See* BS Opp'n ¶¶ 1-2, 5; FH Opp'n ¶¶ 4-7, 11; Ex. C; Ex. D. Thus, the legal and factual issues presented in the Oppositions and Cancellation Actions are clearly intertwined.

2. Consolidation Serves the Interests of Efficiency and Judicial Economy.

When determining whether to consolidate proceedings, the Board weighs the savings in time, effort, and expense which may be gained from consolidation against any prejudice or inconvenience the consolidation may cause. TBMP § 511; *see also, e.g., World Hockey Ass'n*, 185 USPQ2d at 248. In light of the common issues of fact and law, consolidation will be "advantageous to [the] parties in the avoidance of the duplication of effort, loss of time, and the extra expense involved in conducting the proceedings [separately]." *World Hockey Ass'n*, 185 USPQ2d at 248. Indeed, if the Board determines that Border Stylo abandoned the GLASS mark, the WRITE ON GLASS mark, and any other GLASS-formative marks, the question of whether the GOOGLE GLASS mark is confusingly similar to the GLASS mark is moot. Moreover, given the overlap between the proceedings, consolidation would serve the interest of judicial economy and ensure consistency with the Board's decision on common issues of law and fact regarding the trademark ownership and likelihood of confusion issues. Furthermore, the consolidation will not prejudice Opposers in any way because both Oppositions were recently

initiated. Google has not answered the Notices of Opposition served by Border Stylo and Factory Holding – indeed, Opposers consented to extensions of time for Google to answer. In addition, discovery has not yet commenced in either Opposition. Finally, in light of Opposers' conflicting purported rights in the GLASS mark and registration, Opposers' own interests would be served by a consolidated proceeding in which the Board can determine whether either Opposer owns any rights in the GLASS mark.

Accordingly, Applicant respectfully requests that if the Board is not inclined to suspend the Oppositions until the conclusion of the Cancellation Actions, that the Board at least consolidate all of the proceedings and reset the relevant schedules.

IV. CONCLUSION

For the foregoing reasons, Google respectfully requests that the Board grant its Motion to Suspend the Oppositions and Consolidate the Cancellation Actions, or, in the Alternative, Consolidate All Proceedings.

Respectfully submitted,

COOLEY LLP

Date: March 12, 2014

By: /Janet L. Cullum/
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Brendan J. Hughes, Esq.
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New York, New York 10036-7798
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Facsimile: (212) 479-6275
Email: trademarks@cooley.com

Counsel for Applicant Google Inc.

CERTIFICATE OF SERVICE

I hereby certify that on March 12, 2014, I mailed the foregoing **MOTION TO SUSPEND THE OPPOSITIONS AND CONSOLIDATE THE CANCELLATION ACTIONS OR, IN THE ALTERNATIVE, CONSOLIDATE ALL PROCEEDINGS** by depositing true and correct copies of the same with the United States Postal Service, first class mail, postage prepaid, in envelopes addressed to Opposer Factory Holding, Factory Holding's counsel, Opposer Border Stylo and Border Stylo's addresses of record with the USPTO:

Factory Holding Company 25, S.L.
Calle Principe De Vergara, 33
28001, Madrid
Spain
(Factory Holding)

Stephen J. Driscoll, Esq.
Saul Ewing LLP
Centre Square West
1500 Market Street, 38th Floor
Philadelphia, PA 19102-2186
(Factory Holding's Counsel)


Border Stylo LLC
7257 Beverly Blvd., Suite 2010
Los Angeles, California 90036

(Border Stylo)

Eric Bergasa
Border Stylo LLC
c/o 1500 Market Street 37th Floor
Philadelphia, PA 19102
(Border Stylo's USPTO Address of Record)

Border Stylo, LLC
729 Seward Street
Los Angeles, California 90038
(Border Stylo's USPTO Address of Record)

Date: March 12, 2014



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Paralegal Specialist
COOLEY LLP
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Washington, DC 20004
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Facsimile: (202) 842-7899
Email: trademarks@cooley.com

214498/DC

EXHIBIT A

TRADEMARK ASSIGNMENT

Electronic Version v1.1

Stylesheet Version v1.1

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Border Stylo, LLC		12/18/2012	LIMITED LIABILITY COMPANY: CALIFORNIA
RECEIVING PARTY DATA			
Name:	Factory Holding Company 25		
Street Address:	Calle Principe de Vergara, 33		
City:	28 Madrid		
State/Country:	SPAIN		
Entity Type:	S.L.: SPAIN		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Registration Number:	3797151	GLASS	
CORRESPONDENCE DATA			
Fax Number:	6192350398		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	619 525 3865		
Email:	docketing@procopio.com		
Correspondent Name:	Barry F. Soalt c/o Procopio Cory et al.		
Address Line 1:	525 B Street, Suite 2200		
Address Line 4:	San Diego, CALIFORNIA 92101		
ATTORNEY DOCKET NUMBER:	HOLDING COMPANY FACTORY		
DOMESTIC REPRESENTATIVE			
Name:	Barry F. Soalt c/o Procopio Cory et al.		
Address Line 1:	525 B Street, Suite 2200		
Address Line 4:	San Diego, CALIFORNIA 92101		

NAME OF SUBMITTER:	Barry F. Soalt
Signature:	/Barry F. Soalt/
Date:	06/06/2013
Total Attachments: 1 source=Assignment GLASS Reg. 3797151#page1.tif	

EXHIBIT B

TRADEMARK ASSIGNMENT

This Trademark Assignment ("Assignment") is made by Border Stylo, LLC, a California limited liability company ("Border Stylo"), in favor of Factory Holding Company 25, S.L., a Spanish company ("Factory Holding Company 25").

WHEREAS, Border Stylo owns all right, title and interest in and to the following trademark and trademark registration ("Trademark"), and the goodwill associated therewith:

Mark

U.S. Reg. No.

GLASS

3,797,151

WHEREAS, Border Stylo desires to assign the Trademark and the goodwill associated therewith to Factory Holding Company 25, and Factory Holding Company 25 desires to accept such assignment.

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, Border Stylo assigns to Factory Holding Company 25, all of its right, title and interest in and to the Trademark, together with the goodwill associated therewith including, without limitation, its right to sue for and collect damages for infringements or other violations of the same, including for past infringements or violations.

Date: December the 18th, 2012

BORDER STYLO, LLC

By: 

Name: Francisco Ortiz von Bismarck

Title: Manager

OHSUSA:731799248.2

EXHIBIT B

TRADEMARK ASSIGNMENT

Electronic Version v1.1

Stylesheet Version v1.1

SUBMISSION TYPE:	CORRECTIVE ASSIGNMENT		
NATURE OF CONVEYANCE:	Corrective Assignment to correct the Name of the Receiving Party previously recorded on Reel 005042 Frame 0879. Assignor(s) hereby confirms the Assignment of entire interest.		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Border Stylo, LLC		08/21/2013	LIMITED LIABILITY COMPANY: CALIFORNIA
RECEIVING PARTY DATA			
Name:	Border Stylo, LLC		
Street Address:	21051 Warner Center Lane		
Internal Address:	Suite 140		
City:	Woodland Hills		
State/Country:	CALIFORNIA		
Postal Code:	91367		
Entity Type:	CORPORATION: CALIFORNIA		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Registration Number:	3797151	GLASS	
CORRESPONDENCE DATA			
Fax Number:	2159724156		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	2159727755		
Email:	trademarks@saul.com		
Correspondent Name:	Gregory S. Bernabeo, Esq.		
Address Line 1:	Centre Square West, 1500 Market Street		
Address Line 2:	38th Floor		
Address Line 4:	Philadelphia, PENNSYLVANIA 19102		
ATTORNEY DOCKET NUMBER:	365039.00004		
		TRADEMARK	

NAME OF SUBMITTER:	Gregory S. Bernabeo
Signature:	/Gregory S. Bernabeo/
Date:	09/04/2013
Total Attachments: 1 source=3797151_CorrectiveAssignment#page1.tif	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

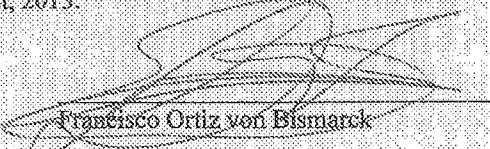
In re Application of:)
Border Stylo, LLC)
Registration No.: 3,797,151)
Filed: March 23, 2009)
Mark: GLASS)

DECLARATION OF FRANCISCO ORTIZ VON BISMARCK

I, Francisco Ortiz von Bismarck, do hereby declare as follows:

1. That on December 18, 2012, U.S. Registration No. 3,797,151 was owned by Border Stylo, LLC;
2. That on December 18, 2012, I personally executed a document entitled Trademark Assignment that appears on its face to assign U.S. Reg. No. 3,797,151 to Factory Holding Company 25.
3. That a true copy of such Trademark Assignment is submitted herewith;
4. That such Trademark Assignment was recorded with the United States Patent and Trademark Office on June 6, 1013, at reel 005042/frame 0879;
5. That the Trademark Assignment indicates that I executed the Assignment in the capacity of Manager of Border Stylo, LLC; and
6. That on December 18, 2012, I was not in fact Manager of Border Stylo, LLC, and have never been Manager of Border Stylo, LLC;
7. That on December 18, 2012, I was not authorized to act on behalf of or bind Border Stylo, LLC;
8. That as a result, the Trademark Assignment was not effective to transfer U.S. Registration No. 3,797,151 to Factory Holding Company 25;
9. That Border Stylo, LLC has been and continues to be the current owner U.S. Registration No. 3,797,151;
10. That I have confirmed my lack of authority to act on behalf of Border Stylo, LLC, and have communicated to Factory Holding Company 25 that I lacked authority to execute the Trademark Assignment on behalf of Border Stylo, LLC, and that the Trademark Assignment is thus ineffective;
11. That Factory Holding Company 25 has acknowledged that the Trademark Assignment was ineffective and that a new agreement would be required to effect an assignment of U.S. Registration No. 3,797,151;
12. That because the Trademark Assignment was ineffective, its recordation was improper;
13. That the payment made by Factory Holding Company 25 in conjunction with execution of the Trademark Assignment was made to my personal bank account;
14. That the payment made by Factory Holding Company 25 in conjunction with execution of the Trademark Assignment was never received by Border Stylo, LLC;
15. That I have caused to be returned to Factory Holding Company 25 the payment made by Factory Holding Company 25 in conjunction with execution of the Trademark Assignment;
16. That after receipt of the payment made by Factory Holding Company 25 in conjunction with execution of the Trademark Assignment, I provided written notice to Factory Holding Company 25 that I had not been authorized to execute the Trademark Assignment, and that the purported Trademark Assignment was invalid and ineffective to transfer ownership of U.S. Registration No. 3,797,151;
17. That in response to my written notice to Factory Holding Company 25, Factory Holding Company 25 acknowledged in writing the defects in the Trademark Assignment; and
18. That all statements made herein are of my own knowledge and are true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and may jeopardize the validity of this application and any registration issuing thereon.

Signed at Zürich, Switzerland, this 21 day of August, 2013.


Francisco Ortiz von Bismarck

1479141.1 08/21/2013

EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 3,797,151
For the Trademark GLASS
Issued on June 1, 2010

GOOGLE INC.,)	
)	
Petitioner,)	
)	Cancellation No.
v.)	
)	
FACTORY HOLDING COMPANY 25, S.L. and)	
BORDER STYLO, LLC,)	
)	
Respondents.)	
_____)	

PETITION TO CANCEL

Petitioner Google Inc. (“Google”), a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043, believes that it is being and/or will be damaged by the continued registration of the GLASS mark (U.S. Registration No. 3,797,151), which was registered on June 1, 2010 (the “Subject Registration”) based on an application filed on March 23, 2009 by Border Stylo, LLC (“Border Stylo”). The U.S. Patent and Trademark Office (“USPTO”) records reflect that Factory Holding Company 25, S.L. (“Registrant”) is the current owner of record of the Subject Registration. Border Stylo also claims ownership of the Subject Registration. Google hereby petitions to cancel the Subject Registration under Section 14 of the Trademark Act of 1947, 15 U.S.C. § 1064.

As grounds for this Petition, Google alleges that:

1. Google is a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043.

2. Google is the owner of the following U.S. trademark applications for GLASS or GLASS-formative marks: Serial No. 85/661,672, filed on June 26, 2012, for the mark GLASS; Serial No. 85/723,835, filed on September 7, 2012, for the mark GOOGLE GLASS; Serial No. 85/900,176, filed on April 10, 2013, for the mark GLASS COLLECTIVE; Serial No. 85/906,147, filed on April 16, 2013, for the mark MYGLASS; and Serial No. 86/008,139, filed on July 11, 2013, for the mark GLASS (stylized) (collectively, “Google’s GLASS Applications”).¹

3. Google has standing to bring this Petition because Registrant has asserted, including in correspondence to Google, that Google’s use and registration of Google’s GLASS and GLASS-formative marks creates a likelihood of confusion with the Subject Registration. Registrant has, among other claims, demanded that Google abandon all trademark applications that include GLASS. In addition, Registrant filed a Notice of Opposition against Google’s application to register GOOGLE GLASS (Opposition No. 91214017) on December 16, 2013 based on the Subject Registration among other marks² (the “FH Opposition”). As further alleged below, Border Stylo has also filed an opposition against Google’s application to register GOOGLE GLASS. Based on, among other reasons, the claims of Registrant and Border Stylo, Google believes that it is and/or will be damaged by the continued registration of the Subject Registration.

4. On information and belief, Registrant is a Spanish limited liability company having its principal place of business at Principe de Vergara, 33, 28001 Madrid, Spain.

¹ Google’s GLASS Applications have a priority date at least as early as March 14, 2012 based on a foreign filed application.

² In the FH Opposition, Registrant asserts rights in marks subject to other trademark applications, each of which was filed after Google’s March 14, 2012 latest priority date.

5. On information and belief, Border Stylo is a California limited liability corporation having its principal place of business at 7257 Beverly Blvd, Suite 2010, Los Angeles, California 90036.

Border Stylo's Use and Registration of its Claimed "Glass Family of Marks"

6. The USPTO records reflect that on or about March 23, 2009, Border Stylo filed Application Serial No. 77/697,375 for the mark GLASS covering certain goods in Class 9 and claiming use of the mark in United States commerce for all goods identified in the application. On March 8, 2010, Border Stylo submitted a Statement of Use in support of that application, declaring under oath that it "is using the mark in commerce on or in connection with the goods/services identified [in the application]" Thereafter, on June 1, 2010, the application matured into the Subject Registration.

7. The Subject Registration covers the following Class 9 goods: "Computer software for enabling users to create customizable text and visual effects on existing websites, and to enable the viewing and sharing of digital images, information and data available on global computer networks; computer software to enable browsing of websites."

8. The USPTO records reflect that Border Stylo also currently owns a registration for the mark WRITE ON GLASS (Registration No. 3,883,602) (the "WRITE ON GLASS Registration"). The WRITE ON GLASS Registration covers the same goods as the Subject Registration and shares the same alleged first use date, namely, February 8, 2010.

9. In a separate opposition proceeding initiated by Border Stylo on December 16, 2013 against Google's application to register GOOGLE GLASS (Opposition No. 91214020), Border Stylo alleges that the Subject Registration is part of a "family of GLASS-formative trademarks" and identifies the WRITE ON GLASS Registration. On information and belief, to the extent

Border Stylo used the GLASS mark, it did not use that mark separate and apart from its “family of GLASS-formative trademarks,” all of which were used in connection with substantially similar software products.

10. On information and belief, by at least as early as December 2011, Border Stylo no longer offered for sale or sold software products under the GLASS mark and no longer maintained an active website advertising or selling any goods or services under the GLASS mark. On information and belief, by at least as early as May 2012, Border Stylo’s founders had pursued other business ventures.

Border Stylo’s Purported Assignment of the Subject Registration

11. On information and belief and the USPTO records, on or about December 18, 2012, Border Stylo executed an Assignment (“Assignment”) purporting to transfer the entire interest and goodwill in the Subject Registration to Registrant. On information and belief, Border Stylo subsequently asserted that the Assignment was invalid and/or has attempted to retract the Assignment.

12. On information and belief, Registrant has not offered for sale or sold goods within the scope of the goods identified by the Subject Registration and/or offered or sold by Border Stylo prior to the date of the Assignment.

13. On information and belief, notwithstanding that the records of the USPTO reflect that the Assignment included a recitation that the Subject Registration was transferred from Border Stylo to Registrant together with the associated goodwill, the Assignment was in fact a naked assignment in that no goodwill was transferred from Border Stylo to Registrant.

CLAIM FOR RELIEF:

ABANDONMENT

14. Google repeats and realleges each and every allegation set forth in Paragraphs 1 through 13 as if fully set forth herein.

15. On information and belief, at least as early as December 2011, Border Stylo ceased using and did not intend to resume use of the GLASS mark, the WRITE ON GLASS mark, or any other mark alleged to be part of its purported “family of GLASS-formative marks” in commerce on or in connection with some or all of the goods and services listed in the Subject Registration or the WRITE ON GLASS Registration. Consequently, Border Stylo abandoned the GLASS Mark, the WRITE ON GLASS Mark, and any GLASS-formative mark included in its alleged family of GLASS-formative marks.

16. Because Border Stylo did not use nor intend to resume use of the GLASS mark with some or all of the goods and services in the Subject Registration for over one year before it assigned the Subject Registration to Registrant, the Subject Registration was invalid and Border Stylo had no rights to transfer to Registrant via the Assignment.

17. Alternatively, on information and belief, the Assignment was ineffective to transfer the goodwill associated with the GLASS Mark and the Assignment was therefore an assignment in gross.

18. The Subject Registration has been asserted by Registrant and Border Stylo as a basis for claiming a likelihood of confusion with Google’s use of and attempts to register GLASS-formative marks. Therefore, the Subject Registration is causing damage and injury to Google.

19. Accordingly, the Subject Registration should be cancelled.

PETITION TO CANCEL
REG. NO. 3,797,151

WHEREFORE, Google requests that the present Petition for Cancellation be sustained
and Registration No. 3,797,151 be cancelled.

Respectfully submitted,

COOLEY LLP

Date: March 4, 2014

By: /Janet L. Cullum/
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Attorneys for Petitioner Google Inc.

CERTIFICATE OF SERVICE

I hereby certify that on March 4, 2014, I mailed the foregoing **PETITION TO CANCEL**, by depositing true and correct copies of the same with the United States Postal Service, postage prepaid, in envelopes addressed to Registrant and Registrant's counsel and to Border Stylo and Border Stylo's address of record with the USPTO:

Factory Holding Company 25, S.L.
Calle Principe De Vergara, 33
28001, Madrid
Spain
(Registrant)

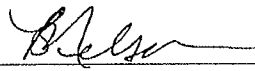
Border Stylo LLC
7257 Beverly Blvd., Suite 2010
Los Angeles, California 90036

(Border Stylo)

Stephen J. Driscoll, Esq.
Saul Ewing LLP
Centre Square West
1500 Market Street, 38th Floor
Philadelphia, PA 19102-2186
(Registrant's Counsel)

Eric Bergasa
Border Stylo LLC
c/o 1500 Market Street 37th Floor
Philadelphia, PA 19102
(Border Stylo's USPTO Address of
Record)

Date: March 4, 2014



Ms. Bonnie Nelson
Paralegal Specialist
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EXHIBIT D

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 3,883,602
For the Trademark WRITE ON GLASS
Issued on November 30, 2010

GOOGLE INC.,)	
)	
Petitioner,)	
)	Cancellation No.
v.)	
)	
BORDER STYLO, LLC,)	
)	
Respondent.)	
_____)	

PETITION TO CANCEL

Petitioner Google Inc. (“Google”), a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043, believes that it is being and/or will be damaged by the continued registration of the WRITE ON GLASS mark (U.S. Registration No. 3,883,602), which was registered on November 30, 2010 (the “Subject Registration”) based on an application filed on March 23, 2009 by Border Stylo, LLC (“Registrant”). The U.S. Patent and Trademark Office (“USPTO”) records reflect that Registrant is the current owner of record of the Subject Registration. Google hereby petitions to cancel the Subject Registration under Section 14 of the Trademark Act of 1947, 15 U.S.C. § 1064.

As grounds for this Petition, Google alleges that:

1. Google is a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043.
2. Google is the owner of the following U.S. trademark applications for GLASS or

**PETITION TO CANCEL
REG. NO. 3,883,602**

GLASS-formative marks: Serial No. 85/661,672, filed on June 26, 2012, for the mark GLASS; Serial No. 85/723,835, filed on September 7, 2012, for the mark GOOGLE GLASS; Serial No. 85/900,176, filed on April 10, 2013, for the mark GLASS COLLECTIVE; Serial No. 85/906,147, filed on April 16, 2013, for the mark MYGLASS; and Serial No. 86/008,139, filed on July 11, 2013, for the mark GLASS (stylized) (collectively, “Google’s GLASS Applications”).

3. Google has standing to bring this Petition because Registrant filed a Notice of Opposition on December 16, 2013 (Opposition No. 91214020) (the “Opposition”) against Google’s application to register the GOOGLE GLASS mark, alleging that Google’s use and registration of the GOOGLE GLASS mark creates a likelihood of confusion with Registrant’s purported “family of GLASS-formative trademarks.” According to Registrant’s allegations in the Opposition, Registrant’s “family of GLASS-formative trademarks” consists of the Subject Registration and its registration for the GLASS mark (Registration No. 3,797,151) (the “GLASS Registration”). Based on, among other reasons, the claims of Registrant, Google believes that it is and/or will be damaged by the continued registration of the Subject Registration.

Registrant’s Use and Registration of its Claimed “GLASS Family Marks”

4. On information and belief, Registrant is a California limited liability corporation having its principal place of business at 7257 Beverly Blvd, Suite 2010, Los Angeles, California 90036.

5. The USPTO records reflect that on or about March 23, 2009, Registrant filed Application Serial No. 77/697,379 for the mark WRITE ON GLASS covering certain goods in Class 9 and claiming use of the mark in United States commerce for all goods identified in the application. On October 8, 2010, Registrant submitted a Statement of Use in support of that

application, declaring under oath that it “is using the mark in commerce on or in connection with the goods/services identified [in the application]” Thereafter, on November 30, 2010, the application matured into the Subject Registration.

6. The Subject Registration covers the following Class 9 goods: “Computer software for enabling users to create customizable text and visual effects on existing websites, and to enable the viewing and sharing of digital images, information and data available on global computer networks; computer software to enable browsing of websites.”

7. In the Opposition, Registrant alleges that it is also the current owner of the GLASS Registration, which covers the same goods as the Subject Registration and shares the same alleged first use date, namely, February 8, 2010.

8. On information and belief, by at least as early as December 2011, Registrant no longer offered for sale or sold software products under the WRITE ON GLASS mark and no longer maintained an active website advertising or selling any goods or services under the WRITE ON GLASS mark. On information and belief, by at least as early as May 2012, Registrant’s founders had pursued other business ventures.

Purported Assignment of the GLASS Registration

9. On information and belief and the USPTO records, on or about December 18, 2012, Registrant executed an assignment (the “Assignment”) purporting to transfer the entire interest and goodwill in the GLASS Registration to Factory Holding Company 25, S.L. (“Factory Holding”). On information and belief, Registrant subsequently asserted that the Assignment was invalid and/or has attempted to retract the Assignment.

CLAIM FOR RELIEF:
ABANDONMENT

10. Google repeats and realleges each and every allegation set forth in Paragraphs 1 through 9 as if fully set forth herein.

11. On information and belief, at least as early as December 2011, Registrant ceased using and did not intend to resume use of the WRITE ON GLASS mark, the GLASS mark, or any other mark alleged to be part of its purported “family of GLASS-formative trademarks” in commerce on or in connection with some or all of the goods and services listed in the Subject Registration or the GLASS Registration. Consequently, Registrant abandoned the WRITE ON GLASS mark, the GLASS mark, and any other GLASS-formative mark included in its alleged family of GLASS-formative marks.

12. Alternatively, on information and belief, the Assignment resulted in the abandonment of the WRITE ON GLASS mark and the GLASS mark because it separated the goodwill associated with the GLASS mark from Registrant’s purported “family of GLASS-formative trademarks.”

13. The Subject Registration has been asserted by Registrant as a basis for claiming a likelihood of confusion with Google’s use and attempt to register the GOOGLE GLASS mark. Therefore, the Subject Registration is causing damage and injury to Google.

14. Accordingly, the Subject Registration should be cancelled.

WHEREFORE, Google requests that the present Petition for Cancellation be sustained and Registration No. 3,883,602 be cancelled.

PETITION TO CANCEL
REG. NO. 3,883,602

Respectfully submitted,

COOLEY LLP

Date: March 6, 2014

By: /Janet L. Cullum/

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New York, New York 10036-7798
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Attorneys for Petitioner Google Inc.

CERTIFICATE OF SERVICE

I hereby certify that on March 6, 2014, I mailed the foregoing PETITION TO CANCEL, by depositing true and correct copies of the same with the United States Postal Service, postage prepaid, in envelopes addressed to Registrant and Registrant's address of record with the USPTO:

Border Stylo LLC
7257 Beverly Blvd., Suite 2010
Los Angeles, California 90036

(Registrant)

Eric Bergasa
Border Stylo LLC
c/o 1500 Market Street 37th Floor
Philadelphia, PA 19102

(Registrant's USPTO Address of Record)

Date: March 6, 2014



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